UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,090	01/13/2004	Derek M. Gledhill	37355-180	3084

5514   7590   09/25/2007
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EXAMINER
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ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
09/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 January 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

2.   **Claims 1-20** are rejected under 35 U.S.C. 102(e) as being anticipated by *Horan*

et al (US 2003/0225663 A1).

        As per claim 1, *Horan et al* discloses a method of calculating asset cost basis

comprising the steps of:

        providing an asset, the ownership of which is tracked in a product system;

reallocating the ownership of the asset (see para 0041-0042 and 0064; via the mutual

fund recordkeeping and portfolio management system **206**).

        categorizing the reallocation of the asset into one of a plurality of categories (see

para 0042 and 0060; via shareowner services **1006** on a wide range of levels and multi-

asset class with engine **304**);

        providing a management system for extracting the information on the asset, the

reallocating of the ownership of the asset and the categorization of the reallocation of

the ownership of the asset from the product system (see para 0041-0042 and Figs.8

and **10;** via system **1012,** services **1006** and Fig.**9** with product system); and

automatically calculating the cost basis change of the asset based on the

categorization of the reallocation of the .ownership of the asset in the management

system (see para 0077 and 0099-0100; via workflow system **208** and accounting and

management system **806** respectively).

As per claim 2, *Horan* discloses the step of codifying the categorization of the.

reallocation of the ownership of the asset prior to automatically calculating the cost

basis change of the asset (see para 009-100; via the accounting and record system 806

through a multi-tier client./server technology inherently codifies the system).

As per claim 3, Horan discloses that the product system is an account (see

Fig.**9;** via Open Platform-Products and account system).

As per claim 4, Horan discloses the step of analyzing the information relating to

the asset, the reallocation of the ownership of the asset, and the categorization of the

reallocation of the ownership of the asset to automatically calculate the cost basis

change of the asset (see para 0064; via portfolio management system **206** includes

tools to track positions, perform analytics etc.).

As per claim 5, *Horan* discloses the step of automatically calculating the cost

basis change for the asset based on the information extracted by the management tool

(see para 0064 and 0100; via automatic calculation of cost basis change).

As per claim 6, *Horan* discloses further the steps of:

providing a portfolio having a plurality of assets distributed in one or a plurality of product systems (see para 0050 and 0052; via reallocate a portfolio);

reallocating the ownership of a plurality of the assets (see para 0041-0042 and 0064; via the mutual fund recordkeeping and portfolio management system **206**);

categorizing the reason for the reallocation of the ownership of each of the assets (see para 0060;via multi asset class); and

automatically calculating the cost basis change of each of the assets based on the categorization of the reason for the reallocation of the ownership of the asset in the management system (see para 0077 and 0099-0100; via workflow system **208** and accounting and management system **806** respectively).

As per claim 7, *Horan* discloses that the reallocation of each asset is categorized by the reason for the reallocation (see para 0042).

As per claim 8, Horan discloses the step of preparing a report relating to the cost basis change of the asset based on the categorization of the change in the ownership of the asset (see para 0080 and 0100; via reporting system **314** and cost basis change).

As per claim 9, Horan discloses the steps of:

reconciling the cost basis change of the asset to the product system (see para 0101; via open reconciliation system **828** as in Fig.8 "Open Recon"); and

preparing a report relating to the cost basis change of the asset (see para 0080 and 0100; via reporting system **314** and cost basis change).

As per claim 10, Horan discloses the step of:

utilizing tax lot information to more accurately determines cost basis change

relating to the reallocation of the asset (see para 0100; via tax lot basis).

As per claim 11, Horan discloses a system for calculating asset cost basis

changes comprising:

a product system (see Fig.8; via Open Platform with Products);

an asset wherein the ownership of the asset is reallocated and tracked in the

account (see para 0041 and 0064; via mutual fund with tracking tool **206**);

means for extracting information from the account relating to the reallocation of

the ownership of the asset via a management system (see para 0101; via open

reconciliation system **828** in Fig.8 and record system **806**); and

means for calculating the cost basis change of the asset based on the

reallocation of the asset (see para 0100; via accounting and management system **806**).

As per claims 12 –14, *Horan* discloses the means for categorizing the

reallocation of the ownership of the asset (see para 0042 and 0060; via recordkeeping

system **1012** shareowner services **1006** on a wide range of levels and multi-asset class

with portfolio accounting engine **304,** inherent with reasons for reallocation of the

ownership of the asset).

As per claim 15, *Horan* discloses the means for calculating the cost basis

change of the asset based on the reallocation of the ownership of the asset

automatically calculates the cost basis change of the asset based on the information

extracted from the account (see para 0100; via accounting and management system

806).

As per claim 16, Horan discloses the information extracted from the account

relates to reasons for reallocating the ownership of the asset (see para 0101; via open

reconciliation system **828** in Fig.8 and record system **806**).

Claim 17 is rejected as per the reason set forth in **claim 4**

As per claim 18, *Horan* discloses a portfolio comprising a plurality of assets in

the account or a plurality of accounts (see para 0052; via a composite of mutual funds);

and

means for calculating the cost basis change of each of the plurality of assets (see

para 010; via accounting and management system 806).

As per claim 19, *Horan* discloses the means for extracting information from the

plurality of assets in the account via the management system (see para 0101; via open

reconciliation system **828** in Fig.8 and record system **806**).

As per claim 20, *Horan* discloses the means for calculating the cost basis

change of each of the plurality of assets is done automatically (see para 0100; via

accounting and management system **806**).

Conclusion

3.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Altomare et al (US 7,249,075 B1) discloses Administering Principal protected

Equity Linked Financial Instruments.

Gardner et al (US 2002/0042764 A1) discloses Financial Portfolio management system to gather financial information from a plurality of sources.

4. .   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed H. Ali whose telephone number is 571-270-3021. The examiner can normally be reached on 8.00 to 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mohamed H Ali
Examiner
Art Unit 3693

MA

9-24-07

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